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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,000	12/18/2001	Nigel Dunn-Coleman	GC696	9426
7590	10/19/2004			
VICTORIA L. BOYD Genencor International, Inc. 925 Page Mill Road Palo Alto, CA 94034-1013			EXAMINER RAO, MANJUNATH N	
			ART UNIT 1652	PAPER NUMBER

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,000

Applicant(s)

DUNN-COLEMAN ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,4-17,19,20,23,24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,9 and 11 is/are rejected.
- 7) ☒ Claim(s) 2,4-7,10,12-17,19,20,23,24 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

#### **CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-3-04 has been entered.

Claims 2, 4-17, 19-20, 23-24, 26 are currently pending and are present for examination.

Applicants' amendments and arguments filed on 8-3-04 have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically, Examiner has withdrawn the previous rejection under 35 U.S.C. 112, 1<sup>st</sup> paragraph in view of claim cancellations.

#### ***Drawings***

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

#### ***Specification***

The disclosure is objected to because of the following informalities: The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable

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code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

It is noted that previously applicant has attempted to correct the specification by deleting only http:// and retaining the “www” in such Web addresses. Examiner urges applicant to delete even the “www” as it can invoke or activate the html language.

### ***Claim Objections***

Claims 2, 4, 23, are objected to because of the following informalities: Claims 2, 4, and 23 recite the name of the enzyme in different manner. For example the enzyme is recited as “β-glucosidase IV” and sometimes as “β-glucosidase 4” and sometimes simply as “β-glucosidase”. Examiner requests applicants to maintain uniformity in the recitation in order to avoid ambiguities. Appropriate correction is required.

On page 3 of the amendment, comprising claims, Examiner requests applicants to delete what appears to be a typographical error. There appears the letter “a” just above claim 4 and does not appear to belong to any claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 and claims 9, 11 which depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites the phrase “a

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polynucleotide sequence (i) having at least 98% sequence homology to the amino acid sequence...". A polynucleotide sequence cannot be directly compared with an amino acid sequence as recited in the claim. It appears applicant intended to recite "a polynucleotide sequence (i) encoding a polypeptide having at least 98% sequence homology to the amino acid sequence...". If that is so amending the claim accordingly would overcome the above rejection.

Claim 8 and claims 9, 11 which depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites the phrase "under conditions of intermediate to high stringency". The metes and bounds of the above phrase is not clear to the Examiner. A perusal of the specification did not provide any specific definition to the above phrase rendering the claims indefinite. Examiner suggests applicants to amend the claim by deleting the intermediate stringency part of the phrase.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-9, 11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims are directed to a genus of DNA molecules having only structural limitations but no functional limitation.

The specification does not contain any disclosure of the function of all DNA sequences that are 98% identical to the sequence encoding the polypeptide depicted in figure 2 or all those polynucleotide that hybridize under highly stringent conditions of those DNA sequence that are simply complementary to the former DNA sequence mentioned above. The genus of DNAs that comprise these above DNA molecules is a large variable genus with the potentiality of encoding many different proteins having different functions. Therefore, many functionally unrelated DNAs are encompassed within the scope of these claims, including partial DNA sequences. The specification discloses only a single species of the claimed genus which is insufficient to put one of skill in the art in possession of the attributes and features of all species within the claimed genus. Therefore, one skilled in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

***Allowable Subject Matter***

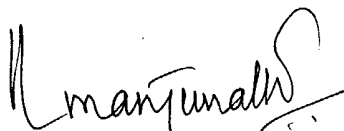
Claims 23-24 are allowable.

Claims 2-7, 10, 12-17, 19-20, 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the

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examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306/9307 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read 'Manjunath N. Rao', with a stylized flourish at the end.

Manjunath N. Rao, Ph.D.

Primary Examiner

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October 13, 2004